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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,951	10/10/2001	Toshiaki Kan-o	MA-502-US	4805
466	7590	08/25/2004		
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER MILLER, BRIAN E	
			ART UNIT	PAPER NUMBER
			2652	
			DATE MAILED: 08/25/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,951

Applicant(s)

KAN-O, TOSHIAKI

Examiner

Brian E. Miller

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) 4,8,13,18 and 22 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 5-6, 9-11, 14-16, 19-20, 24-26 is/are rejected.
7) ☐ Claim(s) 3,7,12,17,21 and 23 is/are objected to.
8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 2652

Claims 1-26 are now pending, with claims 4, 8, 13, 18, 22 remaining withdrawn as being directed to a previously set forth restriction requirement.

Drawings

1. It is noted that although Applicant indicated a replacement sheet for FIG. 8 was attached to the response, none can be found. It is respectfully requested that applicant file another copy with response to the next office communication.

Translation

2. Applicant also indicated (on page 18 of the response) that a verified translation of applicant's Priority document was submitted with the response, however, it is not presently found with the file. It is again respectfully requested that applicant file another copy with response to the next office communication.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2652

5. Claims 2-9, 11-14, 16-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly presented claim language including “non-deformable member” and “a rigid member” constitutes new matter because it is not supported by the original disclosure. The specification (page 13, lines 16-22) recites “The patch 10 for scratch prevention is *formed of a material whose hardness is lower than that of the disk medium 1* such as a DVD-ROM disk *in order to be less likely to be deformed* and to be scratched when force is applied and is attached to the edge portion 3a of the disk insertion and discharge slot 3 of the panel so as to face the disk medium 1.” (emphasis added by the Examiner). There is no description to support the now claimed invention.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 6, 9, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Isomura (JP 63-187492). (As per claims 6 & 20) Isomura discloses a disk drive unit with which a disk medium is to be mounted for access, as depicted in FIGs. 1-3, including a member 21b, 22b which prevents scratching of the disk medium by being provided on an edge of the disk insertion

Art Unit: 2652

and discharge slot 14; wherein the felt pad members are necessarily formed of a material whose hardness is lower than the hardness of the disk medium (re claim 9).

8. Claims 1, 10, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 2000-298906) in view of applicant's admitted prior art (AAPA) FIG. 5. Kato discloses a disk drive unit which a disk medium 9 is inserted, as shown in at least FIG. 2, including: a disk insertion and discharge slot 2 on a front panel 1; a flexible member 3 which has a slit 7 for insertion of the disk medium along a longitudinal direction; a plurality of perpendicular positioned slits 6 provided at a "predetermined interval".

Kato is silent only to the member 3 being made of felt. The AAPA discloses a slotted disk drive unit with a felt member disposed in the slot. From this, it would have been obvious to have formed the flap members 8 of Kato of felt in place of rubber as substituting known materials for one another with similar characteristics would have involved only routine skill in the art.

Claim Rejections - 35 USC § 103

9. Claims 2, 5, 11, 14, 16, 19, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato in view of the AAPA as applied to claims 1, 10, 15 above, and further in view of Isomura. Kato is silent as to a further scratch prevention member provided on the edge of the insertion slot, however, Isomura discloses a disk drive unit with which a disk medium is to be mounted for access, as depicted in FIGs. 1-3, including a member 21b, 22b which prevents scratching of the disk medium by being provided on an edge of the disk insertion and discharge slot 14; wherein the felt pad members are necessarily formed of a material whose hardness is

Art Unit: 2652

lower than the hardness of the disk medium (as per claims 5, 14 & 19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the scratch prevention member to Kato as taught by Isomura. The motivation would have been: adding a scratch prevention member would have further eased the insertion of the medium as would have been readily apparent to a skilled artisan.

With respect to claims 24-26 and the plurality of slits between the ends of the felt member, while Kato is silent to these, it would have been considered obvious to have provided more slits. It would have been evident to a skilled artisan that having more slits would have further eased insertion of the disk, and adding such slits would not constitute patentable subject matter over the prior art of record.

Allowable Subject Matter

10. Claims 3, 7, 12, 17, 21, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed 5/24/04 have been fully considered but they are not fully persuasive.

A...Without the certified translation present, the Examiner cannot withdraw the rejection(s) of record pertaining to Kato.

B...With respect to the newly added language to claims 2, 6, 11, 16, 20, a new 112 paragraph 1 rejection has been set forth, supra.

Art Unit: 2652

C...New claims 24-26 are considered to include limitations that would have been considered obvious to a skilled artisan, as set forth, supra.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (703) 308-2850. The examiner can normally be reached on M-TH 7:15am-4:45pm (and every other friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "B. E. Miller", is positioned above the printed name.

Brian E. Miller
Primary Examiner
Art Unit 2652

Bem
February 20, 2004